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PTO/SB/21 (08-03)

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/062,857
Filing Date	October 25, 2001
First Named Inventor	Erlander, et al.
Art Unit	1637
Examiner Name	Joyce Tung
Total Number of Pages in This Submission	Attorney Docket Number 022041-000320US

### ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="margin-left: 20px;">Petition Under 37 CFR 1.183, Return Postcard</div>
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Townsend and Townsend and Crew LLP Kawai Lau	
Signature		
Date	11/25/03	

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Pamela Skelton		
Signature		Date	November 25, 2003

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$ ) 795.00

<i>Complete if Known</i>	
Application Number	10/062,857
Filing Date	October 25, 2001
First Named Inventor	M. Erlander et al
Examiner Name	Joyce Tung
Art Unit	1637
Attorney Docket No.	022041-000320US

**METHOD OF PAYMENT (check all that apply)**

Check  Credit Card  Money Order  Other  None  
 Deposit Account:

Deposit Account Number

20-1430

Deposit Account Name

Townsend and Townsend and Crew LLP

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

**FEE CALCULATION**
**1. BASIC FILING FEE**

Large Entity      Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ )

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid

Large Entity      Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ )

\*\* or number previously paid, if greater; For Reissues, see above

<b>FEE CALCULATION (continued)</b>					
3. ADDITIONAL FEES	Large Entity	Small Entity			
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive – unavoidable	
1453	1,330	2453	655	Petition to revive – unintentional	
1501	1,330	2501	655	Utility issue fee (or reissue)	665
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130
1807	50	1807	50	Petitions related to provisional applications	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					
*Reduced by Basic Filing Fee Paid				SUBTOTAL (3)	(\$ ) 795.00

**SUBMITTED BY**

Complete (if applicable)

Name (Print/Type)	Kawai Lau	Registration No. (Attorney/Agent)	44461	Telephone	858-350-6100
Signature				Date	11/25/03

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
FOR FAILURE TO NOTIFY THE OFFICE OF A FOREIGN OR INTERNATIONAL  
FILING (37 CFR 1.137(f))**

Docket Number (Optional)  
022041000320

First named inventor: M. Erlander

Application No.: 10/062,857

Art Unit: 1235

Filed: 25 October 2001

Examiner: J. Tung

Title: NUCLEIC ACID AMPLIFICATION

Attention: Office of Petitions

**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: (703) 308-6916

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703)305-9282.

The above-identified application became abandoned pursuant to 35 U.S.C. 122(b)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational international treaty that requires publication of applications eighteen months after filing. The date of abandonment is the day after the expiration date of the forty-five (45) day period set in 35 U.S.C. (122(b)(2)(B)(iii)).

**PURSUANT TO 37 CFR 1.137(f), APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION  
UNDER 37 CFR 1.137(b)**

1. Petition fee
  - Small entity – fee \$665.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.
  - Other than small entity - fee \$\_\_\_\_\_ (37 CFR 1.17(m))
2. Notice of Foreign or International Filing (35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c))

Subsequent to the filing of the above-identified application, an application was filed in another country, or under a multinational international treaty (e.g., filed under the Patent Cooperation Treaty), that requires publication of applications eighteen months after filing. The filing date of the subsequently-filed foreign or international application is 21 December 2001.

[Page 1 of 2]

12/02/2003 SSANDARA 00000019 201430 10062857

01 FC:2453

665.00 DA

**STATEMENT:** The entire delay in filing the required notice of a foreign or international filing from the due date for the required notice until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.  
**[NOTE:** The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

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25 November 2003

Date

Signature

Telephone

Number: 858-350-6151

Kawai Lau, Ph.D. (Reg. No. 44,461)

Typed or printed name

TOWNSEND and TOWNSEND and CREW

Two Embarcadero Center, 8th Floor

San Francisco, CA 94111-3834

Address

Fax: 415-576-0300

Enclosures:  Fee Payment

- Additional sheets containing statements establishing unintentional delay
- Other: Authorization to charge fees to Deposit Account 20-1430, referencing docket no. 022041000320. Petition Under 37 C.F.R. § 1.183 to waive the fee under 37 C.F.R. § 1.17(m).

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

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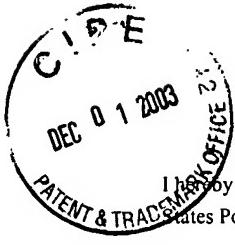
25 November 2003

Date

Signature

Pamela Skelton

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On November 25, 2003

TOWNSEND and TOWNSEND and CREW LLP

By: Pamela Seltzer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

M. ERLANDER et al.

Application No.: 10/062,857

Filed: 25 October 2001

For: NUCLEIC ACID  
AMPLIFICATION

Customer No.: 20350

Confirmation No.: 1235

Examiner: J. Tung

Technology Center/Art Unit: 1637

**PETITION UNDER TO 37 C.F.R. § 1.183 TO WAIVE  
THE FEE UNDER 37 C.F.R. § 1.17(m)**

**Office of Petitions**  
Alexandria, VA 22313-1450

Dear Madam or Sir:

Applicants respectfully request, under the conditions of 37 C.F.R. § 1.183, a waiver of the fee required under 37 C.F.R. § 1.17(m) to accompany a Petition for Revival of an application from an unintentional abandonment under 37 C.F.R. § 1.137(f) and 1.137(b). Alternatively, Applicants request a waiver of the fee under 37 C.F.R. § 1.17(m) in favor of the fee under 37 C.F.R. § 1.17(l), which is more appropriate to the instant facts. A Petition for

12/02/2003 SSANDARA 0000019 201435 10056857  
02 FC:1460 130.00 DA

Revival under 37 C.F.R. § 1.137(f) is enclosed herewith. Also submitted herewith is authority to charge the requisite fee under 37 C.F.R. § 1.17(h) of \$130.00 as required by 37 C.F.R. § 1.183.

The requested waiver will prevent the unjust result of the enclosed Petition for Revival from exacting higher fee (for an unintentional abandonment) from Applicants when the facts of the abandonment in the instant application clearly indicate that the higher fee is not applicable.

Background

The instant application was filed on October 25, 2003, which was after the events of September 11, 2001 and during an ongoing crisis involving the transmission of anthrax spores via the U.S. Postal Service. The application was filed with a Request for Nonpublication.

On December 21, 2001, Applicants filed a corresponding international application based on the instant application under the Patent Cooperation Treaty (PCT) at the U.S. Receiving Office (U.S. RO). Unfortunately, Applicants were still without the Application Serial Number for the instant application and so could not file any correspondence in the instant application, such as correspondence required under 35 U.S.C. § 122(b)(2)(B)(ii)-(iii) and 37 C.F.R. § 1.213(b)-(c).

Applicants were faced with the fact that 37 C.F.R. § 1.5(a) specifically states that "[n]o correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office." The rule also states that any correspondence not containing the application serial number "will be returned to the sender".

Therefore, Applicants waited until receipt of the serial number in the instant application to file a Request to Rescind the previous nonpublication request. This Request to Rescind would have been filed in the instant application along with the corresponding PCT application on December 21, 2001 if the serial number for the instant application was available to Applicants. Prosecution of the instant application continued up to the present, and no notice of abandonment was ever received by Applicants or their agents.

In late March 2003, the undersigned learned of views at the U.S. Patent and Trademark Office (PTO) that a Request to Rescind might not be sufficient to satisfy the notice of

foreign filing within 45 days requirement under 35 U.S.C. § 122(b)(2)(B)(iii) and 37 C.F.R. § 1.213(c). Because the PTO position appeared to be in flux, Applicants filed a communication on May 13, 2003 (mailed May 9, 2003) setting forth the above facts and setting forth Applicants' belief that they satisfied the requirement by virtue of filing the corresponding PCT application with the U.S. RO. The communication also noted that the instant application was apparently delivered to the PTO on February 4, 2002 as evidenced by Attachment A hereto. Attachment A is a copy of a U.S. Postal Service Express Mail tracking page which shows the transit history of the instant application from mailing on October 25, 2001 to delivery on February 4, 2002.

A review of calendar years 2001 and 2002 shows that 45 days from December 21, 2001 (the date of filing for the PCT application) is February 4, 2002, which was the earliest date upon which the PTO could have sent a serial number to Applicants was February 4, 2002. This is consistent with the fact that Applicants' representatives received a return postcard receipt on February 21, 2002. Accordingly, Applicants could not have satisfied the 45 day deadline of 35 U.S.C. § 122(b)(2)(B)(iii) with a notice because no application serial number was available in light of the facts and so no correspondence could have been made in light of 37 C.F.R. § 1.5(a).

Subsequently, the PTO issued at 1272 Off. Gaz. Pat. Office (July 1, 2003) a clarification of its position with respect to the requirement of a notice of foreign filing under 35 U.S.C. § 122(b)(2)(B)(iii). The undersigned learned of this clarification on October 30, 2003 during a presentation by Bob Spar, Director of the Office of Patent Legal Administration (OPLA) of the PTO, in San Diego, California.

Specifically, the clarification includes the position that if a Request to Rescind a nonpublication request in a U.S. application is filed before or on the date of a non-U.S. application such as a PCT application, the U.S. application will be treated as if the nonpublication request was never made. This would have been the case for the instant application if Applicants were not unduly delayed by the events after September 11, 2001 in obtaining the serial number of the instant application.

During a discussion of the above with Mr. Spar, the undersigned was directed to contact his office with respect to this issue in the instant application. The undersigned did so on

multiple occasions starting with October 31, 2003 and finally was finally advised that only a Petition to Revive under 37 C.F.R. § 1.137(f) and 1.137(b) was available as a remedy.

Analysis and Request

A review of the above facts shows that contrary to the language of 35 U.S.C. § 122(b)(2)(B)(iii), which only permits revival of an application for unintentional abandonment, it is entirely possible for an unavoidable abandonment to occur. Accordingly, Applicants respectfully submit that they should not be required to remit the higher fees for an unintentional abandonment when the facts demonstrate that an unavoidable abandonment occurred.

As noted above, Applicants intended to comply with the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) and 37 C.F.R. § 1.213(c) at the time the corresponding PCT application was filed by filing a Request to Rescind nonpublication in the instant application. If the serial number for the instant application was not unduly delayed, Applicants' intended action would have prevented the abandonment in light of the subsequent PTO clarification at 1272 Off. Gaz. Pat. Office (July 1, 2003).

Therefore, Applicants respectfully request that the requirement of a fee under 37 C.F.R. § 1.17(m) be waived because the facts of the instant case are not those of an unintentional abandonment. However, Applicants respectfully point out that no waiver of the requirements under 35 U.S.C. § 122(b)(2)(B)(iii) is sought. Instead, Applicants only seek a waiver of the fee administratively set forth by the PTO at 37 C.F.R. § 1.17(m) and required under 37 C.F.R. § 1.137(f) and 1.137(b).

Alternatively, Applicants respectfully request that the fee under 37 C.F.R. § 1.17(m) be waived and substituted by the fee under 37 C.F.R. § 1.17(l) which is applicable in cases of unavoidable abandonment. Obviously, this fee is more applicable in the instant case, where a situation of unavoidable abandonment occurred.

Either of the above requested waivers, if granted, would avoid the unjust result of requiring the higher fees of a revival for unintentional abandonment when the facts are clearly those of an unavoidable abandonment.

Conclusion

In light of the above, Applicants respectfully submits that it would be unjust to require that Applicants pay the fee under 37 C.F.R. § 1.17(m), which is applied in cases of unintentional abandonment. While Applicants have complied with the statutory requirements for revival based on an unintentional abandonment because that is the only remedy provided, Applicants believe it to be within the power of the PTO to prevent the injustice of requiring an inappropriate fee where the alternatives of waiving the fee, or substituting the fee with another that is more appropriate, are available.

Therefore, Applicants respectfully requests the granting of this petition and fee waiver.

If the Office of Petitions believes that a discussion with the undersigned may be of help in advancing the issues raised by the instant petition, the undersigned would appreciate the opportunity to assist the Office following contact via the information provided below.

The Assistant Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. § 1.17 that may be required by this petition, or to credit any overpayment to Deposit Account No. 20-1430, referencing docket no. 022041000320. However, the Assistant Commissioner is not authorized to charge the issue fee to the Deposit Account.

Respectfully submitted,



Kawai Lau, Ph.D.  
Reg. No. 44,461

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
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